

## REMARKS

Responsive to the Office Action mailed on November 30, 2006 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

### Present Status of Application

Claims 1, 2, 6-9 and 14-29 are pending in the application. Claims 1, 2, 5-9, 14-20, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa et al (US 5,600,203, hereinafter "Namikawa") in view of Ellison et al (US 20020079611, hereinafter "Ellison"). Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa in view of Ellison and in further view of Yakou et al (US 5,855,637, hereinafter "Yakou"). Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa in view of Ellison and in further view of Guenther et al (US 6,949,880, hereinafter "Guenther").

In this paper, claims 1 and 25 are amended as discussed in further detail below. Support for the amendments can be found at least in Figs. 1B-1C, 4B-4C and the related disclosure in the specification.

Reconsideration of this application is respectfully requested in light of the amendments and the remarks contained below.

### Rejections Under 35 U.S.C. 103(a)

Claims 1, 2, 5-9, 14-20, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa in view of Ellison. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa in view of Ellison and in further view of Yakou. Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa in view of Guenther. To the extent that the grounds of the rejections may be applied to the claims now pending in this application, they are respectfully traversed.

MPEP 2142 reads in part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In connection with the third criteria, MPEP 2143.03 goes on the state:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As amended, claim 1 recites a method of repositioning display spacers using inductive attraction, comprising the steps of providing magnetic spacers; providing an inductive chuck to attract the magnetic spacers by magnetic force, wherein a voltage is applied to the inductive chuck and the magnetic spacers are lifted by the inductive chuck, wherein the magnetic spacers directly contact the inductive chuck; providing a substrate; aligning the spacers with desired positions on the substrate; and interrupting the voltage applied to the inductive chuck, wherein the magnetic spacers directly contact the substrate.

Similarly, claim 25 recites a method of repositioning display spacers using inductive attraction, comprising the steps of providing spacers made of electrostatic materials; providing an inductive chuck to attract the spacers by electrostatic force, wherein a voltage is applied to the inductive chuck and the spacers are lifted by the inductive chuck, wherein the spacers directly contact the

inductive chuck; providing a substrate; aligning the spacers with desired positions on the substrate; and interrupting the voltage applied to the inductive chuck, wherein the spacers directly contact the substrate.

In the rejections of claims 1-24, the Examiner identifies anode substrate 2, Ni element 113, and magnetic elements 114 on glass substrate 7 of Namikawa as the alleged substrate, magnetic spacers, and inductive chuck of claim 1. Ellison is relied upon to teach the application and interruption of voltage to control a clamping force. See page 2 of the office action.

Similarly, in the rejections of claims 25-29, the Examiner identifies anode substrate 2, Ni element 113, and magnetic elements 114 on glass substrate 7 of Namikawa as the alleged substrate, magnetic spacers, and inductive chuck of claim 25. Ellison is relied upon to teach the application and interruption of voltage to control a clamping force. Furthermore, Guenther is relied upon to teach the use of electrostatic force as a clamping force. See page 5 of the office action.

Claim 1 recites the step of interrupting the voltage applied to the inductive chuck, wherein the magnetic spacers directly contact the substrate. Claim 25 recites the step of interrupting the voltage applied to the inductive chuck, wherein the spacers directly contact the substrate. In Namikawa, on the other hand, the alleged spacers (i.e., Ni material 113) do not directly contact the alleged substrate (i.e., anode substrate 2) after the glass fiber bundle pieces 6 are aligned on the anode substrate 2. To the contrary, Ni material 113 is separated from the alleged substrate at least by the length of glass fiber bundle pieces 6. See Figs. 12A to 12H.

It is therefore Applicant's belief that even when taken in combination, the prior art references relied upon by the Examiner do not teach or suggest all the limitations of claims 1 and 25. For at least this reason, a *prima facie* case of obviousness cannot be established in connection with these claims. Furthermore, as it is Applicant's belief that a *prima facie* case of obviousness is not established for claims 1 and 25, the Examiner's arguments in regard to the dependent claims are considered moot and are not addressed here. Allowance of claims 1, 2, 6-9 and 14-29 is respectfully requested.

Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so. The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to Deposit Account No. **502447**. In particular, if this response is not timely filed, then the commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 C.F.R. § 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to Deposit Account No. **502447**.

Respectfully submitted,

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